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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,164	08/28/2001	Amit Patel	967.060US1	4647

21186 7590 01/27/2005

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EXAMINER

JIANG, SHAOJIA ANNA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,164

Applicant(s)

PATEL ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on October 21, 2004 wherein claims 1-12 and 22-29 have been amended. Claims 13-21 are cancelled.

Currently, claims 1-12 and 22-29 are pending in this application.

Claims 1-12 and 22-29 are examined on the merits herein.

Applicant's amendment filed October 21, 2004 with respect to the rejection of claims 22-28 made under 35 U.S.C. 112 first paragraph for containing new subject matter which was not described in the original specification and claims (i.e., "a first phase") and the rejection of 22-28 under 35 U.S.C. 112, second paragraph, for indefinite recitation of record stated in the Office Action dated June 16, 2004 have been fully considered and found persuasive to remove these rejections since claims 22-28 have been amended.

The following is new rejection(s) necessitated by Applicant's amendment filed on October 21, 2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment submitted October 21, 2004 with respect to amended claims 1-12 have been fully considered but is deemed to insert new matter into the claims.

The omission of an essential element of the invention "cetyl palmitate, cetearly alcohol and cetearth-12, dicaprylyl ether" and "steareth-2, PPG-15, and stearyl ether" in claims herein is deemed to raise new matter issue, i.e., an issue regarding whether the inventor had possession of a broader, more generic invention. See, e.g., >PIN /NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1248, 64 USPQ2d 1344, 1353 (Fed. Cir. 2002). As noted in MPEP 2163, A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See Gentry Gallery, 134 F.3d at 1480, 45 USPQ2d at 1503; In re Sus, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962).

In the instant case, the specification as originally filed clearly disclose that these ingredients "cetyl palmitate, cetearly alcohol and cetearth-12, dicaprylyl ether" and "steareth-2, PPG-15, and stearyl ether" are considered to be essential and critical elements of the invention (see "Summary of the Invention" at page 2 line 21-23; "Detailed Description" at page 3 line 26-28). More importantly these ingredients

exemplified in Example 1 and 2 at page 12-13, dicaprylyl ether besides Emulgade SE in Example 1, and "stearth-2, PPG-15, and stearyl ether" but not Emulgade SE in Example 2.

Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 contain trademark/trade name Emulgade SE. Where a trademark or trade or abbreviation name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the abbreviation or trademark or trade name cannot be used properly to identify any particular material or product. A abbreviation or trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name, Emulgade SE, is used to identify/describe particular agents, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (6,221,345), Palinczar (4,724,139), and Kasat et al. (5,424,070) in view of Mecca (3,927,021) and Ross et al. (5,605,682) for same reasons of record stated in the Office Action dated June 16, 2004.

Esser discloses that dicapryl ether, cetearyl alcohol, Ceteareth-20, and water, and antiperspirant such as aluminum chlorohydrate are useful in antiperspirant deodorant compositions. See abstract, col.4-5 Example 1-5, col.11 Example 11-12 and claims 1-2. Esser discloses particularly the amount of water phase in the antiperspirant deodorant compositions, 5-80% by weight (see col. 2 lines 17-18), and specific amounts of each ingredient in the composition (see the particular Example 11-12; claims 1-2). Esser also discloses that the antiperspirant deodorant compositions therein are stable and can be a solid or a semi-solid or a cream, and further comprise various ingredients known in the art used in antiperspirant deodorant compositions (see col.3-4), further combining with glycerol (also known as glycerin as recited in claim 1, see col.2 lines 38-40).

Palinczar discloses that glycery stearate, cetyl palmitate, fatty alcohols and antiperspirant such as aluminum chlorohydrates are useful in antiperspirant deodorant compositions in a form as a stick. See abstract, col.4 lines 55-64, col.5 lines 5-15.

Kasat et al. discloses that Eumulgin compounds such as Ceteareth-12 and Ceteareth-20, and antiperspirant and deodorant active material are useful in antiperspirant deodorant compositions. See abstract, col.4 lines 50-64.

The prior art does not expressly disclose the employment of the combination of water and allantoin, and ceteareth-20, cetyl palmitate, cetearl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol, and, and antiperspirant such as aluminum chlorohydrate in antiperspirant deodorant compositions which may be in various forms such as a spray, a roll-on, or a wipe.

Mecca discloses that allantoin is well known to possess soothing, keratolytic moisturizing and anti-irritant properties; allantoin is known to combine with various aluminum salts such as aluminum chlorohydroxy allantionate, used in deodorants, antiperspirants, and other cosmetic products (see col.1 lines 5-19, Example 2-4 at clo.3-4).

Ross et al. discloses the antiperspirant deodorant compositions therein comprising aluminum chlorohydrates, allantoin, palmitate, water in their specific amounts, in a solid or a spray, (see Example I-VI and col.1 lines 10-15)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the combination of water and allantoin, and ceteareth-20, cetyl palmitate, cetearl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol,

and, and antiperspirant such as aluminum chlorohydrate in antiperspirant deodorant compositions which may be in various forms such as a spray, a roll-on, or a wipe.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the combination of water and allantoin, and ceteareth-20, cetyl palmitate, cetearl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol, and, and antiperspirant such as aluminum chlorohydrate in antiperspirant deodorant compositions which may be in various forms such as a spray, a roll-on, or a wipe, since each of these components is a known and art-recognized ingredient to be useful in antiperspirant deodorant compositions based on the prior art. Moreover, the combination of ceteareth-20 and two or more of cetyl palmitate, cetearl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol, and water is well known to be useful in various cosmetic compositions including antiperspirant deodorant compositions.

More importantly, it has been held that it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for same purpose in order to form a third composition that is to be used for the very same purpose; idea of combining them flows logically from their having been individually taught in prior art. *In re Kerkhoven*, 205 USPQ 1069, CCPA 1980. See MPEP 2144.06.

Thus, the combination of these well known and art-recognized ingredients in their known amounts known to be used in antiperspirant deodorant compositions are all deemed obvious, since they are all within the knowledge and conventional skills of cosmetic art, involving merely routine skill in the art. It has been held that it is within the

skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Response to Argument

Applicant's arguments filed October 21, 2004 with respect to this rejection made under 35 U.S.C. 103(a) as being unpatentable of record in the previous Office Action have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicants argue that Esser does not include any other ingredients claimed such as coco-caprylate/caprate, Emulgade SE, glycerin, or allantoin. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In *re Keller*, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); In *re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145.

In this case, as pointed out in the previous Office Action, all cited primary references, Esser, Palinczar, and Kasat et al. disclose that antiperspirant deodorant compositions may comprise the instant ingredients. Moreover, all ingredients are known and art-recognized ingredients to be useful in antiperspirant deodorant compositions based on the combined teachings of the prior art. Further, the combination of cetareth-20 and two or more of cetyl palmitate, cetearl alcohol, cetareth-12, dicapryl ether, caprate, cetearyl alcohol, and water is well known to be useful in various cosmetic compositions including antiperspirant deodorant compositions.

Note that it has been held that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for same purpose in order to form a third composition that is to be used for the very same purpose; idea of combining them flows logically from their having been individually taught in prior art. *In re Kerkhoven*, 205 USPQ 1069, CCPA 1980. See MPEP 2144.06.

Thus, the combination of these well known and art-recognized ingredients in their known amounts known to be used in antiperspirant deodorant compositions are all deemed obvious, since they are all within the knowledge and conventional skills of cosmetic art, involving merely routine skill in the art. It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). See MPEP 2145.

Therefore, the motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

The record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

Note that arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

In view of the rejections to the pending claims set forth above, no claims are allowed.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.
Primary Examiner,
Art Unit 1617
January 12, 2005